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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,267	06/12/2001	L. Garren Du	12587-015001	3522

26212 7590 12/11/2008  
FISH & RICHARDSON P.C.  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440-1022

EXAMINER
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FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3621

NOTIFICATION DATE	DELIVERY MODE
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12/11/2008

ELECTRONIC

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/879,267  
Filing Date: June 12, 2001  
Appellant(s): DU ET AL.

Faustino A. Lichauco (Registration No. 41,942)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 24, 2007 appealing from the Office action mailed October 23, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is not correct. This Examiner's Answer contains a new grounds of rejection.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

20020077988	SASAKI et al.	6-2002
20030225696	NIWA	12-2003

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6226618	DOWNS et al.	5-2001
EP 1041823	SAITO et al.	10-2000
20030023564	PADHYE et al.	1-2003

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5,10,14-18,23, 27-31,36, 40, 43, and 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Publication No. 2002/0077988 to Sasaki et al. ("Sasaki") in view of U.S. Publication No. 2003/0225696 to Niwa.

Referring to claim 1, Sasaki discloses receiving digital content and metadata associated with the digital content (i.e. the metadata is implemented as a content header that includes information relating to an associated digital work), receiving publication information comprising distribution information that identifies one or more content distributors (i.e. the content header may include a distributor identifier) selected to distribute the digital content (see paragraphs [0038], lines 4-16 and [0040], claim 1 and fig.4; each digital work transmission involves the packaging of the digital work and the associated content header into an encrypted transfer file that may be securely transmitted from one participating entity to another), storing the digital content at a first computing system (see paragraph [0013]- each of the portable media devices

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comprises a memory for storing digital content), and sending the metadata and publication information to a computing system for storage (see paragraph [0016] a licensed digital content distributor that is configured to transmit to one or more portable media devices metadata associated with a broadcasted digital content and containing an embedded distributor identifier). Sasaki does not expressly disclose sending the metadata and the publication information to a second computing system for storage separately from the first computing system. Niwa discloses sending the metadata and the publication information (i.e. information describing the content) to a second computing system for storage separately from the first computing system (see paragraphs [0072] and [0073] – the description database stores a content description table containing information describing the content... the description database and the video segment database are provided in separate storage media). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Sasaki to include the step of sending the metadata and the publication information to a second computing system for storage separately from the first computing system. One of ordinary skill in the art would have been motivated to do this because promotes quick data transmission by reducing the amount of information stored on a data storage device. Also, storing the metadata and publication information separately from the content helps to reduce unauthorized usage of content. That is, such storage arrangement prevents users from editing an expired file to extend their usage term.

Referring to claim 2, Sasaki discloses the method wherein receiving digital content includes receiving digital content from a digital content management (DCM) system (see

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paragraph [0040], license manager transmits the transfer file to commercial distributor which in turn transmits the digital content to end users).

Referring to claim 3, Sasaki discloses receiving publication information includes receiving publication information using a graphical user interface (GUI), (see paragraph [0035], lines 6-12 the graphical user interface may display the title and other information relating to one or more digital works).

Referring to claims 4 and 30, Sasaki discloses the digital content includes at least one of streaming video content, music content, graphic content, print content, sound content or audio content (see paragraph [0007]).

Referring to claims 5 and 31, Sasaki discloses the metadata includes at least one of a name, length, publisher, location, or description associated with the digital content (see paragraph [0038]; the metadata is implemented as a content header that includes information relating to an associated digital work).

Referring to claims 10, 50 –52, Sasaki discloses producing protected digital content includes controlling access to the digital content over a network (see paragraph [0046]; The encrypted content package and the encrypted content key may be packaged into a file that is transmitted to the recipient user. The metadata and content key associated with each digital work not only control a user's access to digital content stored on the user's playback device.).

Referring to claim 14, Sasaki discloses a memory unit and a processor configured to (see paragraph [0034] server computer includes a processing unit, a system memory) receive digital content and metadata associated with the digital content (i.e. the metadata is implemented as a content header that includes information relating to an associated digital work), receive

publication information comprising distribution information that identifies one or more content distributors (i.e. the content header may include a distributor identifier) selected to distribute the digital content (see paragraphs [0038], lines 4-16 and [0040], claim 1 and fig.4; each digital work transmission involves the packaging of the digital work and the associated content header into an encrypted transfer file that may be securely transmitted from one participating entity to another), store the digital content at a first computing system (see paragraph [0013]- each of the portable media devices comprises a memory for storing digital content) and send the metadata and publication information to a computing system for storage (see paragraph [0016] a licensed digital content distributor that is configured to transmit to one or more portable media devices metadata associated with a broadcasted digital content and containing an embedded distributor identifier). Sasaki does not expressly disclose send the metadata and the publication information to a second computing system for storage separately from the first computing system. Niwa discloses sending the metadata and the publication information (i.e. information describing the content) to a second computing system for storage separately from the first computing system (see paragraphs [0072] and [0073] – the description database stores a content description table containing information describing the content... the description database and the video segment database are provided in separate storage media). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the apparatus disclose by Sasaki et al. to send the metadata and the publication information to a second computing system for storage separately from the first computing system. One of ordinary skill in the art would have been motivated to do this because promotes quick data transmission by reducing the amount of information stored on a data storage device. Also, storing the metadata and

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publication information separately from the content helps to reduce unauthorized usage of content. That is, such storage arrangement prevents users from editing an expired file to extend their usage term.

Referring to claim 15, Sasaki discloses the processor is configured to digital content includes receiving digital content form a digital content management (DCM) system (see paragraph [0040], license manager transmits the transfer file to commercial distributor which in turn transmits the digital content to end users).

Referring to claim 16, Sasaki discloses the processor is configured to receive publication information includes receiving publication information using a graphical user interface (GUI), see paragraph [0035], lines 6-12 the graphical user interface may display the title and other information relating to one or more digital works).

Referring to claim 17, Sasaki discloses the digital content includes at least one of streaming video content, music content, graphic content, print content, sound content or audio content (see paragraph [0007]).

Referring to claims 18 and 43, Sasaki discloses the metadata includes at least one of a name, length, publisher, location, or description associated with the digital content (see paragraph [0038]; the metadata is implemented as a content header that includes information relating to an associated digital work).

Referring to claim 23, Sasaki discloses the processor is configured to control access to the digital content over a network (see paragraph [0046]; The encrypted content package and the encrypted content key may be packaged into a file that is transmitted to the recipient user. The



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metadata and content key associated with each digital work not only control a user's access to digital content stored on the user's playback device.).

Referring to claim 27, Sasaki discloses receive digital content and metadata associated with the digital content (i.e. the metadata is implemented as a content header that includes information relating to an associated digital work), receive publication information comprising distribution information that identifies one or more content distributors (i.e. the content header may include a distributor identifier) selected to distribute the digital content (see paragraphs [0038], lines 4-16 and [0040], claim 1 and fig.4; each digital work transmission involves the packaging of the digital work and the associated content header into an encrypted transfer file that may be securely transmitted from one participating entity to another), store the digital content at a first computing system (see paragraph [0013]- each of the portable media devices comprises a memory for storing digital content) and send the metadata and publication information to a second computing system for storage (see paragraph [0016] a licensed digital content distributor that is configured to transmit to one or more portable media devices metadata associated with a broadcasted digital content and containing an embedded distributor identifier). Sasaki et al. do not expressly disclose send the metadata and the publication information to a second computing system for storage separately from the first computing system. Niwa discloses sending the metadata and the publication information (i.e. information describing the content) to a second computing system for storage separately from the first computing system (see paragraphs [0072] and [0073] – the description database stores a content description table containing information describing the content... the description database and the video segment database are provided in separate storage media). At the time the invention was made, it would

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have been obvious to a person of ordinary skill in the art to modify the apparatus disclose by Sasaki to send the metadata and the publication information to a second computing system for storage separately from the first computing system. One of ordinary skill in the art would have been motivated to do this because promotes quick data transmission by reducing the amount of information stored on a data storage device. Also, storing the metadata and publication information separately from the content helps to reduce unauthorized usage of content. That is, such storage arrangement prevents users from editing an expired file to extend their usage term.

Referring to claim 28, Sasaki discloses instructions for causing the computer to produce protected digital content wherein the digital content is received from a digital content management (DCM) system (see paragraph [0040], license manager transmits the transfer file to commercial distributor which in turn transmits the digital content to end users and paragraph [0034] server computer includes a hard drive...hard drive contain computer-readable media disks that provide storage for computer executable instructions).

Referring to claim 29, Sasaki discloses instructions for causing the computer to receive publication information includes receiving publication information using a graphical user interface (GUI), (see paragraph [0035], lines 6-12 the graphical user interface may display the title and other information relating to one or more digital works and paragraph [0034] server computer includes a hard drive...hard drive contain computer-readable media disks that provide storage for computer executable instructions).

Referring to claim 36, Sasaki discloses instructions for causing the computer to produce protected digital content includes controlling access to the digital content over a network (see

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paragraph [0046]; The encrypted content package and the encrypted content key may be packaged into a file that is transmitted to the recipient user. The metadata and content key associated with each digital work not only control a user's access to digital content stored on the user's playback device and paragraph [0035], lines 6-12 the graphical user interface may display the title and other information relating to one or more digital works and paragraph [0034] server computer includes a hard drive...hard drive contain computer-readable media disks that provide storage for computer executable instructions).

Referring to claim 40, Sasaki discloses a digital content management (DCM) computer (i.e. content owner) configured to receive digital content and metadata associated with the digital content from a digital content management computer (i.e. license manager), receive publication information, store the digital content at the DCP computer, in response to a request by the DCP computer and a digital rights management (DRM) computer (i.e. commercial distributor) configured to receive the metadata and the publication information from the DCP computer, and store the metadata and the publication information, the publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content (see paragraphs [0031], [0041] and claim 1 above). Sasaki does not expressly disclose the digital management computer send the metadata and the publication information to a digital right management computer for storage separate from the DCP computer. Niwa discloses sending the metadata and the publication information (i.e. information describing the content) to a second computing system for storage separately from the first computing system (see paragraphs [0072] and [0073] – the description database stores a content description table containing information describing the content... the description database and the video segment

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database are provided in separate storage media). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sasaki to send the metadata and the publication information to a second computing system for storage separately from the first computing system. One of ordinary skill in the art would have been motivated to do this because promotes quick data transmission by reducing the amount of information stored on a data storage device. Also, storing the metadata and publication information separately from the content helps to reduce unauthorized usage of content. That is, such storage arrangement prevents users from editing an expired file to extend their usage term.

Referring to claim 53, Sasaki discloses instructions for causing the computer to produce protected digital content (see paragraph [0046]; The encrypted content package and the encrypted content key may be packaged into a file that is transmitted to the recipient user. The metadata and content key associated with each digital work not only control a user's access to digital content stored on the user's playback device and paragraph [0034] server computer includes a hard drive...hard drive contain computer-readable media disks that provide storage for computer executable instructions).

Referring to claim 54, Sasaki discloses storing metadata for the digital content in association with publication information for the digital content, the publication information identifying one or more content distributors selected to distribute the digital content and enabling secure distribution of the digital content according to the stored publication information (see [0015] and claim 1 above). Sasaki does not expressly disclose the metadata being stored separately from the digital content. Niwa disclose the metadata (i.e. information describing the content) being stored separately from the digital content (see paragraphs [0072] and [0073] – the

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description database stores a content description table containing information describing the content... the description database and the video segment database are provided in separate storage media). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Sasaki to store the metadata separately from the content. One of ordinary skill in the art would have been motivated to do this because promotes quick data transmission by reducing the amount of information stored on a data storage device. Also, storing the metadata and publication information separately from the content helps to reduce unauthorized usage of content. That is, such storage arrangement prevents users from editing an expired file to extend their usage term.

Referring to claim 55, Sasaki discloses generating a protected version of the digital content and using the metadata and the publication information to control access to the protected version of the digital content (see claim 10 above).

3. Claims 6, 9, 19, 22, 32 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki and Niwa as applied to claims 1, 50, 14 and 53 above.

Referring to claims 6, 19, 32 and 44, Sasaki discloses publication information (see claims 1 and 14 above). Sasaki does not expressly disclose the publication information further comprises at least one of pricing, rights, or catalog information associated with the digital content. However this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The receiving steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). At the

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time the invention was made, it would have been obvious to a person of ordinary skill in the art to receiving publication information including any type of content because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 9, Sasaki discloses producing thumbnail information (i.e. "preview sample clips") associated with the digital content (see paragraphs [0038] and [0057]). Sasaki does not expressly disclose storing the thumbnail information into a hypertext transfer protocol (HTTP) directory such that the thumbnail information is accessible over a network, but this is an inherent step. Sasaki discloses an Internet web site that presents a collection of digital content including previews (see paragraph [0038]), which implies that the web site, which utilizes a HTTP protocol, stores the previews (thumbnail information). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Sasaki to include the step of storing the thumbnail information into a hypertext transfer protocol (HTTP) directory such that the thumbnail information is accessible over a network. One of ordinary skill in the art would have been motivated to do this because it dramatically improves the content browsing process by making it easier and faster to manage and download large images.

Referring to claim 22, Sasaki discloses the processor is configured to produce thumbnail information (i.e. "preview sample clips") associated with the digital content (see paragraphs [0038] and [0057]). Sasaki does not expressly disclose storing the thumbnail information into a hypertext transfer protocol (HTTP) directory such that the thumbnail information is accessible over a network, but this is an inherent step. Sasaki discloses an Internet web site that presents a

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collection of digital content including previews (see paragraph [0038]), which implies that the web site, which utilizes a HTTP protocol, stores the previews (thumbnail information). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the apparatus disclose by Sasaki to store the thumbnail information into a hypertext transfer protocol (HTTP) directory such that the thumbnail information is accessible over a network. One of ordinary skill in the art would have been motivated to do this because it dramatically improves the content browsing process by making it easier and faster to manage and download large images.

Referring to claim 35, Referring to claim 22, Sasaki discloses instructions to produce thumbnail information (i.e. "preview sample clips") associated with the digital content (see paragraphs [0038], [0057] and paragraph [0034] server computer includes a hard drive...hard drive contain computer-readable media disks that provide storage for computer executable instructions). Sasaki does not expressly disclose storing the thumbnail information into a hypertext transfer protocol (HTTP) directory such that the thumbnail information is accessible over a network, but this is an inherent step. Sasaki discloses an Internet web site that presents a collection of digital content including previews (see paragraph [0038]), which implies that the web site, which utilizes a HTTP protocol, stores the previews (thumbnail information). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the article disclose by Sasaki to store the thumbnail information into a hypertext transfer protocol (HTTP) directory such that the thumbnail information is accessible over a network. One of ordinary skill in the art would have been motivated to do this because it

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dramatically improves the content browsing process by making it easier and faster to manage and download large images.

4. Claims 7,13,20,33, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki and Niwa as applied to claims 50, 1,14, and 53 respectively above, and further in view of US Patent No. 6226618 to Downs et al. ("Downs").

Referring to claim 7, Sasaki discloses producing protected digital content includes encrypting the digital content (see paragraph [0041], lines 1-4, license manger may package digital content and metadata into an encrypted content package). Sasaki et al. do not expressly disclose storing the encrypted digital content into a file transfer protocol (FTP) directory such that the digital content is accessible over a network. Downs discloses storing the encrypted digital content into a file transfer protocol (FTP) directory such that the digital content is accessible over a network (see col. 67, lines 56-63; col. 68, lines 20-22; Content SC(s) for the Content are transferred via FTP to the designated Content Hosting Site(s). The Metadata SC(s) is transferred via FTP to the Content Promotions Web Site. Here the SC(s) are staged to a new Content directory). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Sasaki to include the step of storing the encrypted digital content into a file transfer protocol (FTP) directory such that the digital content is accessible over a network. One of ordinary skill in the art would have been motivated to do this because it utilizes a protocol known for effectively exchanging files over the Internet.

Referring to claim 13, Sasaki discloses metadata and publication information comprising distribution information that identifies one or more content distributor (see claim 1 above).



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Sasaki does not expressly disclose notifying a digital content distributor of the availability of metadata and publication information associated with the digital content. Downs discloses notifying a digital content distributor of the availability of metadata and publication information associated with the digital content (see col. 18 table, step 130). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Sasaki to include the step of notifying the distributors of availability. One of ordinary skill in the art would have been motivated to do this because it provides effective customer service.

Referring to claim 20, Sasaki disclose the processor is configured to encrypt the digital content (see paragraph [0041], lines 1-4, license manger may package digital content and metadata into an encrypted content package). Sasaki does not expressly disclose the processor is configured to store the encrypted digital content into a file transfer protocol (FTP) directory such that the digital content is accessible over a network. Downs discloses storing the encrypted digital content into a file transfer protocol (FTP) directory such that the digital content is accessible over a network (see col. 67, lines 56-63; col. 68, lines 20-22; Content SC(s) for the Content are transferred via FTP to the designated Content Hosting Site(s). The Metadata SC(s) is transferred via FTP to the Content Promotions Web Site. Here the SC(s) are staged to a new Content directory). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the apparatus disclose by Sasaki to store encrypted digital content into a file transfer protocol (FTP) directory such that the digital content is accessible over a network. One of ordinary skill in the art would have been motivated to do this because it utilizes a protocol known for effectively exchanging files over the Internet.

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Referring to claim 33, Sasaki discloses instructions to encrypt the digital content (see paragraph [0041], lines 1-4, license manger may package digital content and metadata into an encrypted content package and paragraph [0034] server computer includes a hard drive...hard drive contain computer-readable media disks that provide storage for computer executable instructions). Sasaki does not expressly disclose storing the encrypted digital content into a file transfer protocol (FTP) directory such that the digital content is accessible over a network.

Downs discloses storing the encrypted digital content into a file transfer protocol (FTP) directory such that the digital content is accessible over a network (see col. 67, lines 56-63; col. 68, lines 20-22; Content SC(s) for the Content are transferred via FTP to the designated Content Hosting Site(s). The Metadata SC(s) is transferred via FTP to the Content Promotions Web Site. Here the SC(s) are staged to a new Content directory). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the article disclose by Sasaki to store encrypted digital content into a file transfer protocol (FTP) directory such that the digital content is accessible over a network. One of ordinary skill in the art would have been motivated to do this because it utilizes a protocol known for effectively exchanging files over the Internet.

Referring to claim 39, Sasaki disclose metadata and publication information comprising distribution information that identifies one or more content distributor (see claim 1 above). Sasaki does not expressly disclose instructions for causing the computer to notify a digital content distributor of the availability of metadata and publication information associated with the digital content. Downs discloses instructions for causing the computer to notify a digital content distributor of the availability of metadata and publication information associated with the digital content (see col. 18 table, step 130 and col. 6, lines 37-40 The Secure Digital Content Electronic

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Distribution System is a technical platform that encompasses the technology, specifications, tools and software need for the secure delivery and rights management of Digital content). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the article disclose by Sasaki to include the step of notifying the distributors of availability. One of ordinary skill in the art would have been motivated to do this because it provides effective customer service.

5. Claims 8, 21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki and Niwa as applied to claims 50, 14 and 53 respectively above, and further in view of European Patent No. 1041823 to Saito et al. ("Saito").

Sasaki discloses producing protected digital content includes encrypting digital content (see paragraph [0041], lines 1-4, license manger may package digital content and metadata into an encrypted content package). Sasaki does expressly disclose storing the encrypted digital content into a real server transfer protocol (RSTP) directory such that the digital content is capable of being streamed over a network. Saito discloses storing the encrypted digital content into a real server transfer protocol (RSTP) directory such that the digital content is capable of being streamed over a network (see paragraphs [0009] & [0046] because the encrypted content is in the form of AV stream data transferred in real time over the Internet, in the first embodiment of the present invention RTP (real-time Transport Protocol) is used as the transport protocol). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Sasaki to include the step of storing the encrypted digital content into a real server transfer protocol (RSTP) directory such that the

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digital content is capable of being streamed over a network. One of ordinary skill in the art would have been motivated to do this because it effectively deliveries streamed multimedia data over the Internet Protocol networks.

Referring to claim 21, Sasaki discloses a processor is configured to encrypt the digital content (see paragraph [0041], lines 1-4, license manger may package digital content and metadata into an encrypted content package). Sasaki does not expressly disclose the processor is configure to store the encrypted digital content into a real server transfer protocol (RSTP) directory such that the digital content is capable of being streamed over a network. Saito et al. disclose storing the encrypted digital content into a real server transfer protocol (RSTP) directory such that the digital content is capable of being streamed over a network (see paragraphs [0009] & [0046] because the encrypted content is in the form of AV stream data transferred in real time over the Internet, in the first embodiment of the present invention RTP (real-time Transport Protocol) is used as the transport protocol). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the apparatus disclose by Sasaki to store the encrypted digital content into a real server transfer protocol (RSTP) directory such that the digital content is capable of being streamed over a network. One of ordinary skill in the art would have been motivated to do this because it effectively deliveries streamed multimedia data over the Internet Protocol networks.

Referring to claim 34, Sasaki discloses instructions to encrypt the digital content (see paragraph [0041], lines 1-4, license manger may package digital content and metadata into an encrypted content package and paragraph [0034] server computer includes a hard drive...hard drive contain computer-readable media disks that provide storage for computer executable

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instructions). Sasaki does not expressly disclose instructions to store the encrypted digital content into a real server transfer protocol (RSTP) directory such that the digital content is capable of being streamed over a network. Saito discloses storing the encrypted digital content into a real server transfer protocol (RSTP) directory such that the digital content is capable of being streamed over a network (see paragraphs [0009] & [0046] because the encrypted content is in the form of AV stream data transferred in real time over the Internet, in the first embodiment of the present invention RTP (real-time Transport Protocol) is used as the transport protocol). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the article disclose by Sasaki to store the encrypted digital content into a real server transfer protocol (RSTP) directory such that the digital content is capable of being streamed over a network. One of ordinary skill in the art would have been motivated to do this because it effectively deliveries streamed multimedia data over the Internet Protocol networks.

6. Claims 11, 12, 24, 25, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki and Niwa as applied to claims 10, 1, 23, 24, 36 and 27 respectively above, and further in view of US Publication No. 2003/0023564 to Padhye et al. ("Padhye").

Referring to claims 11,24 and 37, Sasaki discloses controlling access to digital content over a network (see claim 10 above). Sasaki does not expressly disclose controlling access using an XrML (eXtensible Rights Markup Language) license. Padhye discloses controlling access using a XrML license (see paragraphs [0038] and [0033]; Protected content can be prepared with document preparation application ...a rights language such as XrML can be used to specify the rights and conditions in rights label. At the time the invention was made, it would have been

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obvious to a person of ordinary skill in the art to modify the method disclose by Sasaki to control access using an XrML license. One of ordinary skill in the art would have been motivated to do this because it is a language that effectively expresses rights and conditions associated with a digital content.

Referring to claim 12, Sasaki discloses metadata and publication information associated with the digital content (see claims 1 and 14 above). Sasaki does not expressly disclose sending a rights-label to a digital content rights management system (DRM), wherein the rights-label includes metadata and publication information associated with the digital content. Padhye discloses sending a rights-label to a digital content rights management system (DRM), wherein the rights-label includes metadata and publication information associated with the digital content (see paragraphs [0071] & [0033] The rights label includes metadata...Rights label associated with protected content and the encryption key used to encrypt protected content can be transmitted to license server). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Sasaki to include the step of sending a rights-label to a digital content rights management system (DRM), wherein the rights-label includes metadata and publication information associated with the digital content. One of ordinary skill in the art would have been motivated to do this because the rights label has a secure mechanism that protects the content when the content is generated (see paragraph [0013] of Padhye).

Referring to claim 25, Sasaki discloses metadata and publication information associated with the digital content (see claims 1 and 14 above). Sasaki does not expressly disclose the processor is configured to send includes sending a rights-label to a digital content rights

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management system (DRM), wherein the rights-label includes metadata and publication information associated with the digital content. Padhye discloses sending a rights-label to a digital content rights management system (DRM), wherein the rights-label includes metadata and publication information associated with the digital content (see paragraphs [0071] & [0033] The rights label includes metadata...Rights label associated with protected content and the encryption key used to encrypt protected content can be transmitted to license server). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the apparatus disclose by Sasaki to include the step of sending a rights-label to a digital content rights management system (DRM), wherein the rights-label includes metadata and publication information associated with the digital content. One of ordinary skill in the art would have been motivated to do this because the rights label has a secure mechanism that protects the content when the content is generated (see paragraph [0013] of Padhye).

Referring to claim 38, Sasaki discloses metadata and publication information associated with the digital content (see claims 1 and 14 above). Sasaki does not expressly disclose the instructions for causing the computer to send includes sending a rights-label to a digital content rights management system (DRM), wherein the rights-label includes metadata and publication information associated with the digital content. Padhye discloses sending a rights-label to a digital content rights management system (DRM), wherein the rights-label includes metadata and publication information associated with the digital content (see paragraphs [0071] & [0033] The rights label includes metadata...Rights label associated with protected content and the encryption key used to encrypt protected content can be transmitted to license server and paragraph [0034] server computer includes a hard drive...hard drive contain computer-readable media disks that

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provide storage for computer executable instructions). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the article disclose by Sasaki to include the step of sending a rights-label to a digital content rights management system (DRM), wherein the rights-label includes metadata and publication information associated with the digital content. One of ordinary skill in the art would have been motivated to do this because the rights label has a secure mechanism that protects the content when the content is generated (see paragraph [0013] of Padhye).

### ***NEW GROUNDS OF REJECTION***

#### ***Claim Rejections - 35 USC § 101***

Claims 54 and 55 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) (en banc).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the

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<sup>1</sup> See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).



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method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, the claim(s) fail prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine. In this case, the method steps appear to be performed without the assistance of any machine. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

#### **(10) Response to Argument**

***Proposed modification changes Sasaki's principle of operation and Proposed modification would render Sasaki unsatisfactory for its intended purpose***

Appellants argue that the proposed modification would render Sasaki unsatisfactory for its intended purpose and changes Sasaki's principle of operation. Particularly, Appellants argue:

- "The intended purpose of the Sasaki system is to prevent misappropriation of copyrighted content. Sasaki achieves this by providing each computing system with both the content and certain metadata that tells the computing system the extent to which that content can be played or distributed. If, as the Examiner suggests, the metadata and content were to be stored on different systems, it would follow that a computing system would lack either the metadata or the content. As a result, the Sasaki system would no longer be able to carry out its intended purpose."
- "Sasaki relies heavily on the presence of both the header and content in the same computing system. The presence of both components enables the computing

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system to determine the extent to which it may play the content. Separating the header and content as proposed would change the fundamental principle of operation of the Sasaki system.”

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, as illustrated by the Office Action mailed October 17, 2005, Sasaki does not expressly disclose sending the metadata and the publication information to a second computing system for storage separately from the first computing system. Niwa, however, cures the deficiency of Sasaki et al. by disclosing this feature. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Sasaki et al. system/method to include the step wherein the metadata and the publication information are sent to a second computing system for storage separately from the first computing system. One of ordinary skill in the art would have been motivated to do this because it promotes quick data transmission by reducing the amount of information stored on a data storage device. Also, storing the metadata and publication information separately from the content helps to reduce unauthorized usage of content. That is, such storage arrangement prevents users from editing an expired file to extend their usage term.

Also, Sasaki indicates in paragraph [0058] that “The systems and methods described” are “not limited to any particular hardware, firmware or software configuration, but rather they may be implemented in any computing or processing environment.” This statement implies that it is possible to modify Sasaki system to send the metadata and the publication information to a

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second computing system for storage separately from the first computing system because such modification would not alter the scope of their invention. Again, Sasaki's invention is "not limited to any particular hardware, firmware or software configuration". Thus, the Examiner notes that since the systems and methods of Sasaki are "not limited to any particular hardware, firmware or software configuration" and "may be implemented in any computing or processing environment", modifying Sasaki with Niwa to send the metadata and publication information to a second computing system is feasible and would not change the "principle of operation" or intended purpose of Sasaki's system. It would therefore be obvious to combine these references to achieve the predictable results of sending the metadata and the publication information to a second computing system for storage separately from the first computing system.

Further, "it is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle." See *KSR v. Teleflex*, 82 USPQ2d 1385, 1390 (U.S. 2007).

***No motivation to combine the references***

In response to Appellants argument that there is no motivation to combine Sasaki and Niwa references. The Examiner notes that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396

<b>Claim 1</b>	<b>Sasaki</b>	<b>Niwa</b>
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A computer-implemented method comprising:		
receiving digital content and metadata associated with the digital content;	the metadata is implemented as a content header that includes information relating to an associated digital work	
receiving publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content;	the content header may include a distributor identifier...each digital work transmission involves the packaging of the digital work and the associated content header into an encrypted transfer file that may be securely transmitted from one participating entity to another paragraphs [0038], lines 4-16, paragraph [0040], claim 1 and fig. 4 for the receiving steps	
storing the digital content at a first computing system; and	paragraph [0013] – each of the portable media devices comprises a memory for storing digital content	
sending the metadata and the publication information	paragraph [0016] – a licensed digital content distributor that is configured to transmit to one or more portable media devices metadata associated with a broadcasted digital content and containing an embedded distributor identifier	
to a second computing system for storage separately from the first computing system		Metadata and the publication information = information describing the content  Paragraphs [0072] & [0073] – the description database stores a content description table containing information

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		describing the content.... The description database and the video segment database are provided in separate storage media
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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any

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amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Joshua Murdough



ANDREW J. FISCHER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

WYNN W. COGGINS  
TECHNOLOGY CENTER DIRECTOR



Vincent Melli

Appeals Practice  
Specialist